REMARKS

This amendment follows the outstanding Official Action dated 11/20/03 and is intended as a complete and proper response thereto. In particular, the present paper is presented with the view of advancing prosecution of this application on its merits and hopefully placing this case in a clear condition for allowance.

In order to render this Amendment responsive, a Petition for Extension of Time to Respond Within the Third Month Pursuant to § 1.136(a) is submitted herewith in duplicate along with the requisite petition fee of $475.00 commensurate with the applicant's small entity status as previously established.

Applicant thanks the Examiner and the Supervisory Patent Examiner for taking the time for the interview of May 19, 2004. In this interview, all claims in general were discussed and in particular, claim 1 of the method claims in comparison to the Maroney 967 patent showing a fluid fruit jet slicer. No agreement was reached in this interview, however further amendments of the claims in general were discussed along with the possibility of filing affidavits relating to secondary considerations in the Section 103 rejection. The applicant believes that supplemental type affidavits will be filed in this case, however the current response should be considered a full and complete response to the outstanding office action.

Claims 1-20 remain in the application. These remaining claims have been amended in accordance with the examiners detailed action and interview. Reexamination and reconsideration of the application, as amended, is requested.

Independent claims 1 and 9 were amended to more clearly claim a supply of seed potatoes and that the seed potatoes are cut completely through by the high pressure water jet after being sorted for cutting. Further, dependent claims 14 and 3 were amended in accordance with the specifications to claim a mixture of water and chemical additives in the water jet. It is believed that these amendments now render all claims in the current application allowable and as such, reexamination and reconsideration of the application as amended is requested.

Claims 1-3, 5-12 and 14-20 were initially rejected under 35 U.S.C. § 103(a) as being unpatentable over Maroney 967 in view of Miles et al. 801. For prior art references to be combined to render obvious a subsequent invention under § 103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. *Uniroyal v. Rudkin-Wiley*, 5 U.S.P.Q. 2d 1434, 1438(Fed. Cir. 1988). The teaching of the references can be combined only if there is some suggestion or incentive in the prior art to do so. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599(Fed. Cir. 1988). Hindsight is forbidden. It is impermissible to use the claims as a framework from which to pick and choose individual references to recreate the claimed invention. *Id.* at 1600; *W.L. Gore*, 220 U.S.P.Q. at 312. Moreover, the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious

unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992); *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). The Maroney 5,528,967 patent has been discussed in previous responses and generally discloses a device which grasps frozen cherries and uses a liquid water jet to cut the cherries in half while leaving the pit intact. Thus, the apparatus uses a water jet at a pressure adjusted so as to not completely sever the fruit or shatter the pit. The Miles et al 801 patent generally discloses a seed potato cutter which sizes potatoes and then cuts them using a knife which is the standard method used today and presents all of the problems solved by the current application. The examiner has used this patent in combination with Maroney to show that it is known to sort seed potatoes and to cut them with a water jet.

Once again, Maroney has been discussed in length and it is submitted that no where is there any teaching in these applications to combine a seed potato cutter as shown with a device for slicing cherries and leaving the pits in tact as discussed in Maroney. The combination of these two applications does not solve the problems presented nor does it teach what is currently claimed in the application.

Further, claims 1-3, 6, 7, 9-11, 16 and 17 have been rejected under U.S.C. § 103(a) as being unpatentable over Maroney as stated above in view of Miles et al., and further in view of Flaming which appears to show a discharge tube for a water jet.

Additionally, claims 4, 8, 13 and 19 have been rejected over Maroney in view of Miles et al. and Flaming as described above, further in view of Mirabello which appears to show multiple cutting heads.

With regard to independent claims 1 and 9 as currently amended, it is believed that these amendments more particularly claim the use of seed potatoes, a supply of seed potatoes and separating them into proper sizes and cutting those that have been sized for cutting as well as a more complete definition of a cut, i.e. that it must go all the way through the potato to sever the potato. This is opposite of the Maroney patent wherein the cut leaves the pit in tact and does not cleanly sever all the way through the fruit, it is believed that these current amendments now more clearly define over the prior art rendering the current invention now patentable.

As previously stated, it is believed there is no teaching in the prior art of record to combine these two applications to solve the problem. In particular, there is no teaching between the Maroney patent, a cherry slicing device, and the Miles et al. patent, a potato sorting patent. In fact, in the potato industry, there have been several attempts at overcoming the problems as described in this application. Generally, these are aimed at method of cleaning or sterilizing the knives used in cutting potatoes. There has been no teaching anywhere to use a water jet to sever the potato and prevent the spread of disease.

Finally, there is no teaching in the Maroney patent that this type of cut prevents any type of disease spread. As such, it is believed that it is not obvious to make this combination and in fact, such a combination between Maroney and Miles et al. is

impermissible as there is no teaching anywhere in these two particular documents which suggests the desirability and thus the obviousness of making this combination. In fact, current work in this area has been directed to the use of knives in cutting potatoes and teaches away from the use of a water jet as currently claimed or other water jet related devices as shown in Maroney.

Thus, it is believed that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to have used the Maroney device in combination with the Miles et al. sorting device to show the applicants current method as claimed. Indeed, the applicant's modifications go substantially beyond merely an alternate use for Maroney and rather is a non-obvious method for preventing the spread of disease and of cutting seed potatoes prior to planting. From this discussion, it is believed that independent claims 1 and 9 are now allowable and thus, the remaining dependent claims are also allowable and any rejections of the remaining independent claims have been rendered moot by the above amendment and discussion.

In light of the foregoing discussion of the applied art of record, the presentation of the amended schedule of claims and the indication as to how such claims are considered to clearly and patentably define over the references, it is believed that the patentable nature of the claims has been demonstrated.

In view of the above remarks, reconsideration and allowance of the claims is kindly requested. Should any matters remain outstanding that may be handle over the phone the examiner is encouraged to call.

Respectfully Submitted,

Date: 5-19-04

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